

REMARKS / ARGUMENTS**I. General Remarks**

Claims 1-37 are pending. Claims 1, 7-12, 16, 18, 19, 20-23, 25, 27, and 29-33 have been amended.

II. Remarks Regarding Amendment to the Specification

Figures 6 and 7 have been amended to add reference numerals 120 and 200. These reference numerals were included in paragraph [0024] of the originally-filed specification, but were inadvertently left off of Figures 6 and 7. As paragraph [0024] indicates, reference numeral 120 refers to a degradable wrap in the form of a string, and reference numeral 220 refers to a tape helically wound around compressible tubular foam element 18. (*See Originally-filed Specification*, at para. [0024].) As these reference numerals were already particularly and distinctly pointed out in the originally-filed specification, Applicants respectfully submit that no new matter has been added by this amendment. Replacement Figures 6 and 7 accompany this reply.

III. Remarks Regarding Double Patenting Rejection

Claims 1, 6, 16, 17, 27, and 28 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 12, 66-68, 70, and 82-84 of copending patent application 10/607,011 to Nguyen *et al.* [hereinafter the “’011 Application”]. Applicants have amended independent claims 1, 16, and 27. Applicants respectfully submit that independent claims 1, 16, and 27 as amended contain limitations not present in the claims of the ‘011 Application. In particular, the claims of the ‘011 Application fail to include the limitation “wherein the degradable wrap comprises a poly(orthoester).” As the ‘011 Application does not claim this limitation, Applicants respectfully submit that the claims of the ‘011 Application cannot for a basis for prima facie case of obviousness as to the claims of the present application. Accordingly, Applicants respectfully request withdrawal of the double patenting rejection as to independent claims 1, 16, 27 and their dependent claims 6, 17, and 28.

IV. Remarks Regarding the 35 U.S.C. § 102 Rejections**A. The 2004/0261994 Patent Publication**

Claims 1, 6-11, 15-22, 26-33, and 37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/0261994 issued to Nguyen *et al.* [hereinafter "*Nguyen*"].

Applicants respectfully submit that the cited reference does not anticipate the rejected claims as amended, because the reference does not teach each and every element set forth in the claims. To form a basis for a § 102(e) rejection, a prior art reference must disclose each and every element as set forth in the claim. See MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). *Nguyen* does not contain each and every element of the claimed invention as amended and as such, the *Nguyen* cannot anticipate Applicants' claims. In particular, *Nguyen* fails to teach the limitation "wherein the degradable wrap comprises a poly(orthoester)." As *Nguyen* does not teach or suggest this limitation, *Nguyen* cannot anticipate the claims of the present invention. Thus, Applicants respectfully request the removal of the 35 U.S.C. § 102(e) rejection as to the independent claims 1, 16, and 27, and correspondingly, dependent claims 6-11, 15, 17-22, 26, 28-33, and 37.

B. U.S. Patent No. 3,099,318 issued to Miller *et al.*

Claims 1, 6, 15-17, 26-28, and 37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,099,318 issued to Miller *et al.* [hereinafter "*Miller*"].

Applicants respectfully submit that the cited reference does not anticipate the rejected claims as amended, because the reference does not teach each and every element set forth in the claims. To form a basis for a § 102(b) rejection, a prior art reference must disclose each and every element as set forth in the claim. See M.P.E.P. § 2131 (2004). *Miller* does not contain each and every element of the claimed invention as amended and as such, *Miller* cannot anticipate Applicants' claims. In particular, *Miller* fails to teach the limitation "wherein the degradable wrap comprises a poly(orthoester)." As *Miller* does not teach or suggest this limitation, *Miller* cannot anticipate the claims of the present invention. Thus, Applicants respectfully request the removal of the 35 U.S.C. § 102(e) rejection as to the independent claims 1, 16, and 27, and correspondingly, dependent claims 6, 15, 17, 26, 28, and 37.

V. Remarks Regarding the 35 U.S.C. § 103(a) Rejections**A. *Miller* in view of *Wehunt***

Claims 2-5 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. U.S. Patent No. 3,099,318 issued to Miller *et al.* [hereinafter "*Miller*"] in view of U.S. Patent 5,507,345 issued to Wehunt *et al.* [hereinafter "*Wehunt*"].

A prima facie case of obviousness requires a showing that all claim limitations be taught or suggested by the art. M.P.E.P. § 2143.03. Applicants respectfully submit that a prima facie case of obviousness has not been established by the cited references, because the cited references, even when taken in combination, fail teach all of the limitations of Applicants' claims. In particular, none of the cited references teach the limitation "wherein the degradable wrap comprises a poly(orthoester)." As none of the cited references teach this limitation, the cited references, even when taken in combination cannot form a basis for a prima facie case of obviousness as to claim 1 or any of its dependent claims.

Further, as provided in M.P.E.P. § 2144.03(C), a conclusion as to the supposed action of a person of ordinary skill in the art is insufficient to establish a prima facie case of obviousness. To the extent that Examiner relies on such a statement or statements to supply the necessary motivation to combine or modify the prior art references, Applicants hereby respectfully traverse the lack of such a showing and request under M.P.E.P. § 2144.03(C) that the Examiner supply an affidavit or other documentary proof establishing the prior art knowledge that would have motivated a person of ordinary skill in the art to make the specific modification and/or combination of elements to arrive at Applicants' invention.

Thus, Applicants respectfully submit that the cited references cannot form a prima facie case of obviousness as to independent claim 1 or any of its dependent claims, 2-5. As such, Applicants respectfully request removal of the 35 U.S.C. § 103(a) rejection as to claims 2-5, which depend either directly or indirectly from claim 1.

B. *Miller* in view of *Voll*

Claims 7-9, 18-20, and 29-31 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. U.S. Patent No. 3,099,318 issued to Miller *et al.* [hereinafter "*Miller*"] in view of U.S. Patent 5,507,345 issued to Voll *et al.* [hereinafter "*Voll*"]. Applicants assume that the reference to Miller '818 Patent in the office action is intended to refer to the Miller '318 Patent.

A prima facie case of obviousness requires a showing that all claim limitations be taught or suggested by the art. M.P.E.P. § 2143.03. Applicants respectfully submit that a prima facie case of obviousness has not been established by cited references, because the cited references, even when taken in combination, fail teach all of the limitations of Applicants' claims. In particular, none of the cited references teach the limitation "wherein the degradable wrap comprises a poly(orthoester)." As none of the cited references teach this limitation, the cited references, even when taken in combination cannot form a basis for a prima facie case of obviousness.

Further, as provided in M.P.E.P. § 2144.03(C), a conclusion as to the supposed action of a person of ordinary skill in the art is insufficient to establish a prima facie case of obviousness. To the extent that Examiner relies on such a statement or statements to supply the necessary motivation to combine or modify the prior art references, Applicants hereby respectfully traverse the lack of such a showing and request under M.P.E.P. § 2144.03(C) that the Examiner supply an affidavit or other documentary proof establishing the prior art knowledge that would have motivated a person of ordinary skill in the art to make the specific modification and/or combination of elements to arrive at Applicants' invention.

Thus, Applicants respectfully submit that the cited references cannot form a prima facie case of obviousness as to independent claims 1, 16, and 27. As such, Applicants respectfully request removal of the 35 U.S.C. § 103(a) rejection as to claims 7-9, 18-20, and 29-31, which depend either directly or indirectly from independent claims 1, 16, and 27.

C. *Miller in view of Sinclair*

Claims 10-14, 21-25, and 32-36 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 3,099,318 issued to Miller *et al.* [hereinafter "*Miller*"] in view of U.S. Patent 5,507,345 issued to Sinclair *et al.* [hereinafter "*Sinclair*"]. Applicants assume that the reference to Miller '818 Patent in the office action is intended to refer to the Miller '318 Patent.

A prima facie case of obviousness requires a showing that all claim limitations be taught or suggested by the art. M.P.E.P. § 2143.03. Applicants respectfully submit that a prima facie case of obviousness has not been established by cited references, because the cited references, even when taken in combination, fail teach all of the limitations of Applicants' claims. In particular, none of the cited references teach the limitation "wherein the degradable

wrap comprises a poly(orthoester).” As none of the cited references teach this limitation, the cited references, even when taken in combination cannot form a basis for a prima facie case of obviousness.

Further, as provided in M.P.E.P. § 2144.03(C), a conclusion as to the supposed action of a person of ordinary skill in the art is insufficient to establish a prima facie case of obviousness. To the extent that Examiner relies on such a statement or statements to supply the necessary motivation to combine or modify the prior art references, Applicants hereby respectfully traverse the lack of such a showing and request under M.P.E.P. § 2144.03(C) that the Examiner supply an affidavit or other documentary proof establishing the prior art knowledge that would have motivated a person of ordinary skill in the art to make the specific modification and/or combination of elements to arrive at Applicants’ invention.

Thus, Applicants respectfully submit that the cited references cannot form a prima facie case of obviousness as to independent claims 1, 16, and 27. As such, Applicants respectfully request removal of the 35 U.S.C. § 103(a) rejection as to claims 10-14, 21-25, and 32-36, which depend either directly or indirectly from independent claims 1, 16, and 27.

SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that no fees are due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P. Deposit Account No. 02-0383, (*formerly Baker & Botts, L.L.P.*), Order Number 063718.0284, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,

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